

Attorney Docket No.: DEX-0214
Inventors: Macina et al.
Serial No.: 09/909,567
Filing Date: July 20, 2001
Page 4

REMARKS

Claim 1 is pending in the instant application. Claim 1 has been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner suggests that lines 3 and 4 of claim 1 recite the phrase "comprising" which may contain sequences which are directed to a lung specific molecule with SEQ ID NO: 12 or expressed by SEQ ID NO:12, plus additional sequences on the ends which are not adequately described in the written description of this application. Further, the Examiner suggests that a sequence which is directed to a "lung specific molecule" with 97% identity to SEQ ID NO:12 may contain sequences that are 100% identical to SEQ ID NO:12 with an additional 3% of sequence on the other end of SEQ ID NO:12 which does not meet the written description provision of 35 U.S.C. § 112, first paragraph.

Applicants respectfully traverse this rejection.

Applicants respectfully disagree with Examiner's suggestion that lines 3 and 4 of claim 1 and the phrase "comprising" lacks

Attorney Docket No.: DEX-0214
Inventors: Macina et al.
Serial No.: 09/909,567
Filing Date: July 20, 2001
Page 5

written description for being inclusive of additional sequences on the end. MPEP § 2163 (page 2100-165 through 2100-166) specifically states that applicant may show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence of that applicant was in possession of the claimed invention including **partial structure**. Accordingly, the instant specification which teaches the 1823 nucleotide sequence of SEQ ID NO:12 clearly meets the written description requirements for a claim drawn to a polynucleotide comprising this sequence.

Applicants also respectfully disagree with the Examiner regarding the application not meeting the written description requirements with respect to part(c). The specification provides detailed teachings at page 23 regarding polynucleotides which share a defined percent of identity with the disclosed polynucleotide of SEQ ID NO:12. Further, methods for determining sequences with a defined % identity to a disclosed sequence are well known and need not be described in detail in the specification. See MPEP § 2163 (page 2100-164).

However, in an earnest effort to advance the prosecution of this case and in accordance with teachings at page 8, lines 2-7,

Attorney Docket No.: **DEX-0214**
Inventors: **Macina et al.**
Serial No.: **09/909,567**
Filing Date: **July 20, 2001**
Page 6

page 9, lines 1-2, page 17, line 28 through page 18, line 18 and page 21, line 15 through page 22, line 15, Applicants have amended the claims to state that the polynucleotide is a variant encoding the same polypeptide as SEQ ID NO:12.

MPEP §2163 (page 2100-169) is clear; if an applicant discloses an amino acid sequence, it is unnecessary to provide an explicit disclosure of nucleic acid sequences encoding the amino acid sequence. Since the genetic code is widely known, a disclosure of an amino acid sequence would provide sufficient information such that one would accept applicant was in possession of the full genus of nucleic acids encoding a given amino acid sequence.

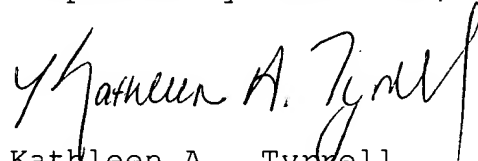
Accordingly, the instant specification, which teaches the nucleic acid sequence of SEQ ID NO:12 as well as the amino acid sequence encoded thereby is demonstrative of possession of the full scope of the invention as now claimed.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph is therefore respectfully requested.

Attorney Docket No.: **DEX-0214**
Inventors: **Macina et al.**
Serial No.: **09/909,567**
Filing Date: **July 20, 2001**
Page 7

Applicants believe that the foregoing comprises a full and complete response to the Office communication of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kathleen A. Tyrrell", written over the printed name.

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Date: **March 9, 2004**

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